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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,376

07/06/2005

Eriko Harada

2005\_1094A

8730

513 7590 08/01/2008

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2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

MAHAFKEY, KELLY J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,376	<b>Applicant(s)</b> HARADA ET AL.	
	<b>Examiner</b> Kelly Mahafkey	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/27/06 &amp; 7/6/05</u> .                                    | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 6, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "non-fat cacao solid" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not recite, "non-fat cacao solids". It is unclear as to what the term is referring to as recited in the claim. Furthermore, the claim recites, "non-fat milk solids or non-fat cacao solids", it is unclear as to what the difference is between "non-fat milk solids" and "non-fat cacao solids".

Claim 3 recites, "the fat ingredient comprises a hard butter or triglycerides represented by SUS". It is unclear as to how triglycerides are "represented by" SUS. It is unclear as to if the triglycerides include SUS in a specific ratio or if the triglycerides are "represented" by the SUS in some other way.

Claims 6 and 10 recite "whipping fat composition". It is unclear as to what characteristics a composition must have in order to be a "whipping fat composition"; it is unclear if the composition needs to have fat and be whipped or if there are other requirements essential to a "whipping fat composition". For the purpose of examination "whipping fat" will be considered "whipping cream" as it is referred to in the specification Page 7 lines 1-4.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Inayoshi et al (EP 0609465 A1).

Inayoshi teaches of an oil in water emulsion comprising 10-50% fat which includes SUS (Page 2 line 47 through page 3 line 4), 1-15% non-fat milk solids (NFMS) (Page 3 lines 14-20), 5-30% sugar (Page 3 lines 21-25), and about 42% water (see example 1 formulation). Inayoshi thus teaches that the ratio of NFMS: Total non-fat solids of about 2% (1/46) to about 72% (15/21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka et al (US 6497914 B1).

Hidaka teaches of an oil in water emulsion (emulsion A) which is mixed or diluted with an aqueous composition of fresh milk or whipping cream (emulsion B) and whipped to form a final whipping cream. Refer Column 3 lines 6-30 and Column 4 lines 55-63. Hidaka teaches that the oil in water emulsion contains 10-35% fat, 3-8% non-fat milk solids (NFMS), and at least about 1% emulsifier, and thus about 56% water (100%-35%-8%-1%). Refer to Column 4 lines 1-28. Hidaka teaches that the fat includes SUS type triglycerides (Column 2 lines 53-59).

Hidaka is silent to the emulsion as containing 10-50% water and 10-70% non-fat solids as recited in claim 1.

Regarding the emulsion as containing 10-50% water and 10-70% non-fat solids, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include additional solids in the whipped cream, such as sugar. One would

have been motivated to include sugar in order to sweet the whipping composition. One would have been further motivated to include an amount of sugar, such as 6%, depending on the desired sweetness in the final product. To do so would be to add a well known ingredient for its known function and would not impart a patentable distinction to the claims. Hidaka teaches that after the ingredients are added, the emulsion is then completed with water, thus the addition of sugar would decrease the amount of water in the composition. One would have been motivated to vary the amount of water in the final composition as a result effective variable depending upon the other properties in the final product, such as the desired amount of fat, sweetness, ect. To do so would be routine determination of one of ordinary skill in the art at the time the invention was made and would not impart a patentable distinction to the claims, absent any clear and convincing arguments and/or evidence to the contrary.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/

/Kelly Mahafkey/

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Primary Examiner

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Examiner

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